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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,672	08/16/2005	Oleg Stenzel	264704US0PCT	1797

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EXAMINER	
SMITH, JENNIFER A	

ART UNIT	PAPER NUMBER
1793	

NOTIFICATION DATE	DELIVERY MODE
03/28/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/522,672	STENZEL ET AL.	
	Examiner	Art Unit	
	JENNIFER A. SMITH	1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 February 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4* is/are pending in the application.

4a) Of the above claim(s) *4-19* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *16 August 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *1/28/2005, 4/7/2005, 10/11/2005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of Application

Applicant's election with traverse to prosecute the invention of Group I (claims 1-4) in the reply filed on 02/11/2008 is acknowledged. The traversal is on the ground(s) that there is no evidence to show that the process of Group II results in materially different precipitated silica than that of Invention I.

This is not found persuasive because cited reference Blume et al. US Patent No. 6,268,424 B1 makes clear the different characteristics [See Claim 5] of the silica obtained from the known process.

The requirement is still deemed proper and is therefore made FINAL.

Claims 5-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claims 1-4 are presented for examination.

Priority

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date as follows:

Receipt is acknowledged of papers filed on 01/28/2005 purporting to comply with the requirements of 35 U.S.C. 119(a)-(d) and they have been placed of record in the file. Attention is directed to the fact that the date for which foreign priority is claimed is not the date of the first filed foreign application acknowledged in the oath or declaration.

The first filed foreign application was filed in Germany on 07/04/2003. A claim for priority under 35 U.S.C. 119(a)-(d) cannot be based on said application, since the United States application was filed more than twelve months thereafter.

Information Disclosure Statements

The information disclosure statement filed on 01/28/2005, 04/07/2005, and 10/11/2005 comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. Accordingly, the information disclosure statements have been considered by the examiner. Please refer to applicants' copy of the 1449 submitted herewith.

Claim Objections

Claim 1 (line 1) is objected to because of the following informalities: Claim is unclear as to what characterizes the silica. To improve clarity, modification to read the following would be appropriate: "A precipitated silica characterized by the following parameters".

Claim 4 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uhrlandt et al. US Patent No. 6,180,076 B1.

In regard to claims 1, US 6,180,076 (D1, hereafter) teaches a precipitated silica with the characteristics [Claim 1]:

- BET surface area is 120-300 m^2/g
- CTAB surface area is 100-300 m^2/g
- DBP index number is 150-300g/100g

Therefore D1 teaches the ranges claimed in the instant application but fails to teach the claimed range of Sears number.

D1 teaches a Sears index, defined as consumption of 0.1 N NaOH, at a value of 6-25 ml [Claim 1] while the instant claim is drawn to a product with a Sears number, defined as V_2, at a value of 23-35 ml/(5g). Looking to the instant specification to equate these two values, Applicant writes that the measurements are standardized to theoretical weighted samples of 1 g and extended by five [Page 16, lines 12-13]. Therefore, extending the values in D1 by five (30-125 ml/5g) would encompass the claimed ranges and the product disclosed in D1 is thought to be substantially the same as the product of instant claim 1.

In addition, it would have been obvious to one of ordinary skill in the art, at the time of applicant's invention, to determine this parameter (Sears number) because it is a measure of the concentration of hydroxyl groups on the surface of the silica.

In regard to claim 2, D1 teaches CTAB surface area is 100-300 m^2/g in claim 1. Therefore a maximum of 300 m^2/g is taught.

In regard to claim 3, D1 teaches the wK coefficient is the ratio of the peak height of the non-degradable particles (B), the maximum of which lies in the range of 1.0-100 µm, to the peak height of the degraded particles (A), the maximum of which lies in the range of <1.0 µm [See Figure 6 or Column 6, lines 27-30]. The WK coefficient is taught in D1 to be less than 3.4 [See Claim 1].

In regard to claim 4, D1 teaches modifying the precipitated silica with organosilanes of the formula I to III [See Column 3, lines 55-65]. The disclosed formulas are the same as those of the instant claim 4.

Nonstatutory Obvious-Type Double Patenting Rejection

A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See,

e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-4 (respectively) of copending Application No. 10/523,029 because the instant application claims a narrower limitation of BET surface area and Sears Number and would have been obvious over the broader range claimed in the copending application. Therefore, it would have been obvious to one skilled in the art to have selected the instant claimed narrower range from the broad range of the co-pending application because the co-pending application has disclosed the same utility in the whole disclosed range.

Claims 1, 3, and 4 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting over claims 2, 6 and 7 (respectively) of copending Application No. 10/516,308 because the copending application claims broader ranges for surface area, DBP number, and sears number. Therefore, it would have been obvious to one skilled in the art to have selected the instant claimed narrower range from the broad range of the co-pending application because the co-pending application has disclosed the same utility in the whole disclosed range.

This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

Conclusion

Claims 5-19 are withdrawn from consideration.

Claims 1-4 are rejected.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENNIFER A. SMITH whose telephone number is (571)270-3599. The examiner can normally be reached on Monday - Friday, 8:30am to 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571)272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roy King/
Supervisory Patent Examiner, Art Unit 1793

Jennifer A. Smith
March 1, 2008
TC 1793

JS